

REPLY UNDER 37 CFR 1.116 -

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Serial No. 09/990,025

Attorney Docket No. 10008081-1

Title: MULTIPLE DEVICE CONFIGURATION AND UPGRADE FOR IMAGING DEVICES

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REMARKSExaminer's Summary of the Claimed Invention

The Examiner summarized the claimed invention under on page 3 of the Final Office Action mailed on January 9, 2008, stating that "The claimed invention relates to an imaging device, computer-usable medium, and methods for upgrading the configuration of a device based on another device's configuration. The system uses the configuration settings of a model device to automatically configure other devices. In which, in the same field of invention, the applied reference teaches the same." See, Final Office Action mailed on January 9, 2008, Page 4, Item 4.

Applicant disagrees with this summary and respectfully maintains that the claimed invention is described only by the limitations of independent claims 1, 6, 8 and 15, and their dependent claims. Specifically, Applicant notes that claims 1, 6, 8 and 15 do not recite internal or external management facilities that retrieve "configuration settings of a model device and uses these configuration settings to automatically configure other devices," but recite internal or external management facilities that command the imaging devices to upgrade and/or configure themselves by "pulling" the configuration data from a selected pre-configured imaging device or network storage location by sending the configuration upgrade command and the network location to retrieve the configuration from. This allows the management facility to not be locked up upgrading any particular device and distributes the load of upgrading a single device or multiple devices on the network. It also allows the target imaging device to upgrade themselves either directly from the selected template source imaging device, or indirectly, from a network site that stores the configuration of the source imaging device.

Applicant also respectfully notes that Paragraph [0017] of the Present Application states, "[0017] As described above, embodiments of the present invention allow for upgrade and configuration of one or more imaging devices on a network from a single pre-configured imaging device. Several possible base embodiments of the present invention exist, primarily differing in the network site that the target imaging devices pull the upgrade configuration information from. In one embodiment of the present invention, a management facility commands the target imaging device(s) to contact the pre-configured source imaging device and

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upgrade themselves from its configuration. In another embodiment of the present invention, the management facility queries the pre-configured source imaging device, collecting its configuration data and storing it locally to the management facility itself. The management facility then commands the target imaging device(s) to contact the network address or network location of the management facility and upgrade themselves from the configuration data there. In yet another embodiment of the present invention, the management facility queries the pre-configured source imaging device, collecting its configuration and storing on a specified local network site. The management facility then contacts the target imaging device(s) and commands them to contact the address of the network site and upgrade themselves from the collected configuration data there. In further embodiment of the present invention, the management facility queries the pre-configured source imaging device, noting its configuration. The management facility then contacts the target imaging device(s) and commands them to contact a remote network site or website where the configuration exists and upgrade themselves to match the configuration of the source imaging device. This embodiment is particularly useful when upgrading device firmware or software. An example of such a remote network site is the universal resource locator (URL) for a website."

*Claim Rejections Under 35 U.S.C. § 102*

Claims 1-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by McIntyre (U.S. Publication No. 2003/0063305). Applicant respectfully traverses this rejection. Applicant reserves the right to swear behind the reference McIntyre et al., but submits that claims 1-20 are allowable for the following reasons.

In the Final Office Action mailed on January 9, 2008, the Examiner stated:

In response to applicant's statement that McIntyre discloses two separate embodiments, MPEP 2136.02 explains that a 35 U.S.C. 102(e) rejection may rely on any part of the patent or application publication disclosure. Under 35 U.S.C. 102(e), the entire disclosure of a U.S. patent, a U.S. patent application publication, or an international application publication having an earlier effective U.S. filing date

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(which will include certain international filing dates) can be relied on to reject the claims. *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 983, 10 USPQ2d 1338, 1342 (Fed. Cir. 1989). See MPEP § 706.02(a).

As claimed, McIntyre also teaches an external management facility sending across a network to a device (i.e. first device) an upgrade command and a network address associated with the desired configuration (i.e. second device). The first device then sends a request for the desired configuration to the second device. McIntyre's second embodiment teaches a printer control program remote to printer 220 sending an update command across a network to printer 220. The configuration settings are stored in storage media 240, which may be located in printer 221. Printer 220 accesses the configuration settings in storage media 240. See paragraphs 33-35.

*See*, Final Office Action mailed on January 9, 2008, Pages 2-3, Item 3.

Applicant respectfully disagrees. Applicant respectfully maintains that the method and apparatus of McIntyre outlined in Paragraphs 33-35, does not teach the elements of claims 1, 6, 8 and 15. Specifically, the Office Action contains elements pulled from separate and different embodiments of McIntyre. Applicant understands that, as stated in MPEP §2136.02, the Examiner is allowed to utilize the whole disclosure of a cited reference. However, Applicant respectfully maintains that, contrary to the Examiner's assertion, combining elements of differing embodiments from a given reference is not permissible for a rejection under 35 U.S.C. § 102(e). *See*, MPEP §2131.

Applicant respectfully maintains that in an anticipation rejection over a prior art reference under 35 U.S.C. § 102 it is error to combine separate embodiments from the reference, picking only those elements that suit the desired rejection. Applicant maintains that a proper rejection for anticipation under 35 U.S.C. § 102 requires that all elements of the rejected claims need to be found in the cited reference, but also that they need to be arranged in same manner as required by the rejected claims. As such, Applicant respectfully maintains that the Office Action's rejection does not take into account the proper legal standard for a rejection under 35 U.S.C. § 102(e), namely that all the elements of the claim must be found arranged in the same manner without the

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need for picking and choosing among multiple embodiments. *See*, MPEP §2131, which states in pertinent part, "the elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)." *See also*, *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972).

In view of the above, Applicant specifically contends that the Office Action impermissibly combined the external management facility 150 sending across a network to a printer an upgrade command and downloading the desired configuration of McIntyre's first disclosed embodiment of Figure 1 and Paragraphs [0027]-[0029] with the local printer control program of the printer 220 of the second embodiment of McIntyre disclosed in Figure 2 and Paragraphs [0032]-[0035] which discloses the local printer control program, accessed on the printer through the printer control panel, storing configuration settings from the printer 220 in storage media 240 for later restoration. The second embodiment of McIntyre also discloses that the storage media 240 of the embodiment may either be located in printer 220 or on a network location allowing other printers 220 to access the configuration settings in storage media 240 when directed by their own local control programs.

Applicant also specifically traverses the Office Action's statements that McIntyre discloses in the first embodiment of McIntyre "an external management facility sending across a network to a device (i.e. first device) an upgrade command and a network address associated with the desired configuration (i.e. second device). The first device then sends a request for the desired configuration to the second device." Applicant has carefully reviewed McIntyre, specifically, Figure 1 and Paragraphs [0027]-[0029], and cannot find any such disclosure. Applicant specifically notes that Paragraph [0029] of McIntyre only states that "[i]nstead of manually reprogramming each printer 120, a user may execute an update command using the printer control program 150. The update command downloads saved control settings for the designated printer 120 or group 125 of printers 120."

In addition, Applicant has carefully reviewed McIntyre and the second disclosed embodiment and also cannot find "a printer control program remote to printer 220 sending an update command across a network to printer 220. The configuration settings are stored in storage media 240, which may be located in printer 221. Printer 220 accesses the configuration settings in storage media 240." In particular, Applicant notes that Figure 2 and Paragraphs [0032]-[0035]

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discloses that "[i]n another embodiment of the present invention, the document production system 200 does not include a computer allowing a user to access a printer control program. Instead, the printer control program 250 is resident within the memory or firmware of each printer 220. An example of this embodiment of the document production system 200 is illustrated in FIG. 2."

As such, Applicant respectfully maintains that the elements recited by the Examiner in the second paragraph of the Office Action section of Item 3 quoted above in rejecting claims 1-20 of the Present Application come from differing embodiments and are being impermissibly combined in the rejection to create the arrangement specified by the pending claims 1-20.

Applicant therefore continues to maintain, as stated previously, that McIntyre discloses two separate embodiments. In the first, shown in Figure 1, a system has networked printers 120 operating under the control of an external printer control program 150 resident on a computer, where any locally customized printer configurations can be saved by the external management program and then downloaded and restored on the printers 120 after a firmware upgrade, either manually or automatically. See, McIntyre, Figure 1 and Paragraphs [0027]-[0029]. Applicant also specifically notes that, as stated in Paragraph [0029] of McIntyre, in this first embodiment, the configurations are only restored to their original printers 120. In addition, Applicant specifically notes that Paragraph [0029] of McIntyre only discloses that these configurations are restored by being downloaded with the update command from the remote printer control program, not by referencing a network location of another printer 120, or network location of another printer's stored configuration, and commanding the designated printer 120 to update itself directly from the other printer or network location by accessing it and pulling the configuration data from the source.

Applicant therefore respectfully submits that the first embodiment disclosed in McIntyre Figure 1 and Paragraphs [0027]-[0029] fails to teach or disclose an imaging device that requests a device configuration to upgrade an internal configuration of the imaging device from a second imaging device across a network upon receiving an external upgrade command given by an external management facility. Applicant also respectfully submits that the first embodiment of McIntyre also fails to teach or disclose a method of upgrading an imaging device, comprising receiving across a network an external upgrade command from an external management facility

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and a network location associated with a desired device configuration for the imaging device, and retrieving the desired device configuration from the network location. As such, Applicant respectfully maintains that the first embodiment of McIntyre fails to teach or disclose all elements of claims 1-20.

In the second embodiment of McIntyre, shown in Figure 2 and described in Paragraphs [0032]-[0035] of McIntyre, the printer control program 250 is only disclosed as being resident on the printers 220, 221 and in operation only saves the local configuration of the printer it is resident on to a storage media 240. The local printer control program resident on the specific printer is then used to select and restore configuration settings from the storage media 240 after firmware upgrade. This storage media 240 can also be networked and be commonly accessible by other printers 220 on the network. However, in this embodiment, McIntyre only discloses in Paragraph [0034] that, once the configuration of a specific printer is saved to the commonly accessible storage media 240, the user can then only load it on to another printer on the network by physically accessing the internal control program 250 resident on the selected printer 220 via the printer's external control panel to download the saved configuration to that printer 220. *See*, McIntyre, Figure 2 and Paragraphs [0032]-[0035].

Applicant therefore continues to respectfully submit that the second embodiment disclosed in McIntyre Figure 2 and Paragraphs [0032]-[0035] fails to teach or disclose an imaging device that requests a device configuration to upgrade an internal configuration of the imaging device from a second imaging device across a network upon receiving an external upgrade command given by an external management facility. Applicant also respectfully submits that the second embodiment of McIntyre also fails to teach or disclose a method of upgrading an imaging device, comprising receiving across a network an external upgrade command from an external management facility and a network location associated with a desired device configuration for the imaging device, and retrieving the desired device configuration from the network location. As such, Applicant respectfully maintains that the second embodiment of McIntyre fails to teach or disclose all elements of claims 1-20.

Applicant also respectfully contends that the Office Action's selected elements alleged to be present do not teach or disclosed the claimed invention and, additionally, are clearly not arranged as required by the claims, since the elements were selected piecemeal by the Office

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Action from two different embodiments within the reference. The elements having been drawn from two different embodiments negates any proper finding of anticipation under 35 U.S.C. § 102(e).

Applicant therefore respectfully submits that McIntyre fails to teach or disclose an imaging device that requests a device configuration to upgrade an internal configuration of the imaging device from a second imaging device across a network upon receiving an external upgrade command given by an external management facility. Applicant also respectfully submits that McIntyre fails to teach or disclose a method of upgrading an imaging device, comprising receiving across a network an external upgrade command from an external management facility and a network location associated with a desired device configuration for the imaging device, and retrieving the desired device configuration from the network location. As such, Applicant respectfully maintains that McIntyre fails to teach or disclose all elements of claims 1-20.

Applicant also notes that, at the time the invention was made, McIntyre and the present application were owned by, or subject to an obligation of assignment to, the same organization. Applicant also notes that the present application (U.S. Patent Application Serial No. 09/990,025) was filed on November 21, 2001. Because McIntyre qualifies as prior art only under 35 U.S.C. § 102(e) having either issued or published less than one year before the priority date of the Present Application and since McIntyre and the present Application were all commonly owned at the time of invention, the Applicant respectfully maintains that the McIntyre patent application cannot be used in support of a rejection under 35 U.S.C. § 103. See, 35 U.S.C. § 103(c).

Applicant's claim 1, recites, in part, "wherein the processing facility is adapted to request a device configuration to upgrade an internal configuration of the imaging device from a second imaging device through the network interface in response to receiving an external upgrade command through the network interface from an external management facility and a network location of the second imaging device." As detailed above, Applicant submits that McIntyre fails to teach or disclose such an imaging device that requests a device configuration from a second imaging device across a network in response to receiving an external upgrade command given by an external management facility. As such, McIntyre fails to teach or disclose all elements of independent claim 1.

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Applicant's claim 6, recites, in part, "communicating with a first imaging device having a device configuration with an external management facility" and "directing the second imaging devices with the external management facility of the first imaging device to update their device configuration using the device configuration of the first imaging device in a manner selected from the group consisting of: retrieving the device configuration from the first imaging device, storing the device configuration of the first imaging device in a storage location, and directing each of the second imaging devices to retrieve the device configuration of the first imaging device from the storage location; and directing each of the second imaging devices to retrieve the device configuration from the first imaging device." As detailed above, Applicant submits that McIntyre fails to teach or disclose such a computer-usable medium having computer-readable instructions stored thereon for execution by a processor to perform a method that requests a device configuration from a first imaging device by a second imaging device when directed by an external management facility across a network. As such, McIntyre fails to teach or disclose all elements of independent claim 6.

Applicant's claim 8, recites, "defining a list of similar imaging devices connected to the network, wherein the similar imaging devices share a common configuration, firmware, software, or supplemental information; defining a network location associated with desired device configuration for the list of similar imaging devices; and directing each imaging device of the list of similar imaging devices with an external management facility to retrieve the device configuration from the network location, by communicating with each imaging device of the list of similar imaging devices across the network with the external management facility." As detailed above, Applicant submits that McIntyre fails to teach or disclose such a method of updating device configuration for imaging devices connected to a network that requests a device configuration an external management facility from a network location across a network. As such, McIntyre fails to teach or disclose all elements of independent claim 8.

Applicant's claim 15, recites, "receiving across a network an external upgrade command from an external management facility and a network location associated with a desired device configuration for the imaging device; and retrieving the desired device configuration from the network location." As detailed above, Applicant submits that McIntyre fails to teach or disclose such a method of upgrading an imaging device that requests a device configuration from a



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network location upon receiving an external upgrade command from an external management facility and a network location associated with a desired device configuration for the imaging device. As such, McIntyre fails to teach or disclose all elements of independent claim 15.

Applicant respectfully contends that claims 1, 6, 8 and 15 as pending have been shown to be patentably distinct from the cited reference. As claims 2-5, 7, 9-14, and 16-20 depend from and further define claims 1, 6, 8 and 15, respectively, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) and allowance of claims 1-20.

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In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 08-2025.

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2207.

Respectfully submitted,

Date:

3/10/08

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